

Serial No. 10/038,223
Docket No. 17MY-7138

REMARKS

In the Office Action, the Examiner reviewed claims 1-18 of the above-identified US Patent Application, with the result that method claims 10-18 were withdrawn from consideration due to a restriction requirement, the specification was objected to for a typographical error, claims 1 and 8 were objected to, and claims 1-9 were rejected under 35 USC §103. In response, Applicant has amended the specification and claims as set forth above. More particularly:

The specification has been reviewed and amended to correctly identify U.S. Patent No. 3,574,601, which was the basis for the Examiner's objection to the specification.

Independent claim 1 has been amended to use the transition phrase "consisting of" instead of "consisting essentially of."

Independent claim 1 has been further amended to delete the "wherein" clause, which contained the basis for the objection to claim 1.

In response to the amendment to their parent claim 1, dependent claims 2 and 6 have been amended to revise the ranges for the Charpy impact toughness and grain size, respectively, of the alloy.

Independent claim 8 has been amended in accordance with the Examiner's suggestion for overcoming the objection to claim 8.

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Finally, new claims 19 and 20, which depend from claim 1, have been presented to recapture subject matter deleted with the "wherein" clause from claim 1, namely, the limitations regarding the delta ferrite content and ultimate tensile strength of the alloy.

Applicant believes that the above amendments do not present new matter. Favorable reconsideration and allowance of claims 1-9, 19 and 20 are respectfully requested in view of the above amendments and the following remarks.

Restriction Requirement

In the Office Action, the Examiner required that Applicant affirm an election under 35 USC §121 between claims 1-9 (Group I) drawn to an alloy, and claims 10-18 (Group II) drawn to a process. During a telephone interview at the Examiner's initiation on January 21, 2003, Applicant's representative provisionally elected with traverse to prosecute Group I, claims 1-9. Applicant hereby affirms the election to prosecute claims 1-9 on the merits.

Objection to the Specification and Claims

The Examiner objected to the disclosure and claims for containing informalities which Applicant has addressed as discussed above. Therefore, Applicant respectfully requests withdrawal of these objections.

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Rejections under 35 USC §103

Independent claim 1 and its dependent claims 2-6 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 4,227,923 to Watanabe et al. (the '923 patent), and dependent claim 7 (which depends from independent claim 1) and independent claim 8 and its dependent claim 9 were rejected under 35 USC §103(a) as being unpatentable over the '923 patent in view of U.S. Patent No. 4,857,120 to Watanabe et al. (the '120 patent). Applicant respectfully traverses each of these rejection in view of the following comments.

Applicant's invention is directed to a precipitation-hardened stainless steel alloy recited in claim 1 as consisting of, by weight:

14.0 to 16.0 percent chromium;

6.0 to 7.0 percent nickel;

1.25 to 1.75 percent copper;

0.5 to 1.0 percent molybdenum;

0.03 to 0.5 percent carbon;

niobium in an amount by weight of ten to twenty times greater than carbon;

and

various optional elements with the balance being iron.

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Under the first §103 rejection, the Examiner explained that the '923 patent discloses an alloy with constituents having overlapping ranges with those of Applicant's claimed alloy. However, the '923 patent requires the presence of 0.5 to 2.0 weight percent cobalt, and even teaches cobalt as being "indispensable" (column 3, lines 40-41). As now amended, Applicant's claim 1 excludes any significant level of cobalt from its possible constituents through the use of the transition phrase "consisting of." Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1-6 under 35 USC §103(a).

Under the second §103 rejection, the Examiner merely cited the '120 patent for teaching that chromium steels are used in steam turbine components. In view of Applicant's remarks above, it is apparent that the '120 patent cannot be said to supplement the teachings of the '923 patent in order to arrive at the alloy recited in Applicant's independent claims 1 (from which claim 7 depends) or 8. While the Examiner concluded in paragraph 13 of the Office Action that "[w]ith respect to the alloy composition of Claim 8, except for Mo, Watanabe et al.'s ('923) composition ranges overlap the ranges . . . of Claim 8 of the claimed invention," Applicant again respectfully notes that the '923 patent includes cobalt as an "indispensable" constituent, whereas claim 8 always excluded any significant amount of cobalt as a result of the use of the transition phrase "consisting of." Therefore, Applicant believes that a prima facie basis for rejecting claim 8 and its dependent claim 9 under 35 USC §103 was not

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properly established in the present Office Action.

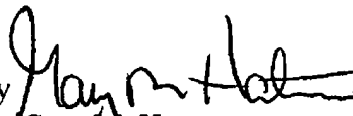
In view of the above, Applicant respectfully requests withdrawal of the rejection of claims 7-9 under 35 USC §103(a).

Closing

In view of the above, Applicant believes that all issues outstanding from the Office Action have been addressed, and that the claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicant's representative may be reached at (219) 462-4999.

Respectfully submitted,

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